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10/006,936	12/05/2001	Herman Chien	83531-322	9281

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EXAMINER
SAMS, MATTHEW C

ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 April 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>4-8,10,17,20-25,28,30-33 and 36-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>4-8,10,17,20-25,28,30-33 and 36-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action has been changed in response to the amendment filed on 4/8/2008.

2.   Claims 4, 5, 7, 10, 21, 25, 28, 30 and 32 have been amended, claims 27 and 35 have been

canceled and claim 39 has been added.

Response to Arguments

3.   Applicant's arguments filed 4/8/2008 have been fully considered but they are not

persuasive.

4.   In response to the applicant's argument regarding "the SIM-based ESN, which is used to

create the AUTHR, are authentication information and are therefore security sensitive

information", the examiner disagrees.

        The SIM-based ESN is part of the authentication process for creating the AUTHR,

however it is not transmitted to the network as the authentication information. The examiner is

reading the "authentication information" as equating to a single value (AUTHR), whereas an

"authentication process" would involve the SIM-based ESN to determine the "authentication

information".

        Applicant's arguments with respect to claims 4-8, 10, 17, 20-25, 28, 30-33 and 36-38

have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 4-8, 28, 30-33 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Peck (US-6,606, 491) in view of Demello et al. (US-2001/0036224 hereinafter, Demello).

Regarding claim 4, Peck teaches a communication device (Fig. 1 [24] and Fig. 2) for use

with a network, the communication device comprising:

a device identifier; (Col. 3 lines 51-53 terminal based ESN)

a register configured to store an anonymous user identifier (Col. 3 lines 13-15 SIM-based

ESN) and authentication information (Col. 7 line 38 "AUTHR") configured to authenticate the

communication device with the network (Col. 2 lines 12-29 and Col. 5 lines 1-5), the anonymous

user identifier being unrelated to the device identifier; (Col. 3 lines 51-57)

a transmitter configured to transmit the authentication information and the anonymous

user identifier to the network; (Fig. 2 [54] and Col. 3 lines 51-57) and

a SIM card (Fig. 2 [90]) comprising a SIM identification number that, at least in part, was

assigned to the SIM by a manufacturer of the SIM (Col. 8 lines 50-52 "the 32-bit SIM-based

ESN can be generated by the operator or SIM card manufacturer"), wherein the anonymous user

identifier is associated with the serial number. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5

lines 21-33)

Peck differs from the claimed invention by not explicitly reciting the anonymous user identifier is unrelated to the authentication information.

In an analogous art, Demello teaches a system and method for delivering personalized content to an anonymous user (Abstract), which includes creating an anonymous user identifier that is unrelated to a device identifier and authentication information. (Page 3 [0035] "one or more specific identifiers on Mediation Servers" & [0038] "The anonymous identification must not allow the determination of the identity of the wireless users") At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the communication device of Peck after modifying it to incorporate the use of an anonymous user identifier of Demello. One of ordinary skill in the art would have been motivated to do this since it enables a mobile user to receive personalized information while maintaining anonymity with the content providers. (Demello Page 2 [0019])

Regarding claim 5, Peck in view of Demello teaches a communication device (Fig. 1 [24] and Fig. 2) comprising a processor (Fig. 2 [68]) configured to encrypt the anonymous user identifier before transmission to the communication network. (Col. 2 lines 12-61 and Col. 7 lines 36-49)

Regarding claim 6, Peck in view of Demello teaches a processor (Fig. 2 [68]) and a user input interface configured to supply commands to the processor. (Fig. 2 [76])

Regarding claim 7, Peck teaches a cellular telephone for use with a network, the cellular telephone comprising:

a memory configured to store a device identifier; (Col. 2 lines 37-39 IMEI)

a display (Fig. 2 [78]) configured to display data and commands; (Col. 6 lines 25-34)

a user input interface for data entry and command entry; (Fig. 2 [76]), a SIM (Fig. 2 [90])

a subscriber identity module having authentication information (Col. 7 line 38 "AUTHR") a SIM serial number (Col. 2 lines 49-61 and Col. 3 lines 51-57) that, at least in part, was assigned to the SIM by a manufacturer of the SIM; (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

a processor (Fig. 2 [68]) configured to determine an anonymous user identifier unrelated to the device identifier as a function of the SIM serial number (Col. 3 lines 51-57), the processor being further configured to issue transmit commands; (Fig. 2 [54] and Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) and

a transmitter configured to receive transmit commands issued by the processor, and to transmit the authentication information and the anonymous user identifier to network following receipt of a transmit command issued by the processor. (Fig. 2 [54], Col. 7 lines 36-49 and Col. 10 lines 20-25)

Peck differs from the claimed invention by not explicitly reciting the anonymous user identifier is unrelated to the authentication information.

In an analogous art, Demello teaches a system and method for delivering personalized content to an anonymous user (Abstract), which includes creating an anonymous user identifier that is unrelated to a device identifier and authentication information. (Page 3 [0035] "one or more specific identifiers on Mediation Servers" & [0038] "The anonymous identification must

not allow the determination of the identity of the wireless users") At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the communication device of Peck after modifying it to incorporate the use of an anonymous user identifier of Demello. One of ordinary skill in the art would have been motivated to do this since it enables a mobile user to receive personalized information while maintaining anonymity with the content providers. (Demello Page 2 [0019])

Regarding claim 8, Peck in view of Demello teaches a cell phone (Fig. 2) wherein the transmitter is configured to transmit the device identifier to the network following receipt of a transmit command issued by the processor. (Col. 3 lines 16-20)

Regarding claim 28, Peck teaches wherein the authentication information includes a MSISDN number. (Col. 1 lines 33-54, Col. 5 lines 18-32 and Col. 7 lines 36-49)

Regarding claim 30, Peck teaches the authentication information includes a mobile subscriber identity. (Col. 2 lines 30-61)

Regarding claim 31, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI). (Col. 2 lines 30-48)

Regarding claim 32, Peck teaches the authentication information includes a mobile subscriber identity (Col. 2 lines 39-42) and a mobile station number. (Col. 1 lines 38-39 MIN, Col. 1 lines 49-54, Col. 2 lines 42-57 and Col. 3 lines 51-57)

Regarding claim 33, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI) and the mobile station number is a mobile station ISDN

number (MSISDN). (Col. 2 lines 30-48) It is well known to one of ordinary skill in the art that the MSISDN is the telephone number of the SIM card, including the country code.

Regarding claim 39, Peck in view of Demello teaches the SIM further comprises the authentication information. (Peck Col. 7 lines 36-45)

7. Claims 10, 17, 20-25 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. (US-6,310,889 hereafter, Parsons) in view of Peck and Demello.

Regarding claim 10, Parsons teaches a content provider configured to communicate with one or more mobile stations (Col. 1 line 54 through Col. 2 line 32) over a network, the content provider comprising:

a content personalization interface configured to receive the anonymous user identifier from at least one of the mobile stations (Col. 8 lines 56-61) and

a processor configured to use the anonymous user identifier to personalize content for the at least one of the mobile stations, and to provide the personalized content to the at least one of the mobile stations. (Col. 8 line 56 through Col. 9 line 29) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not explicitly reciting the user identifier is based on a SIM serial number, unrelated to the device identifier and associated with the SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as an anonymous user identifier (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33), authentication information for authenticating the mobile station with the network (Col. 7 line 38 "AUTHR"),

wherein the anonymous user identifier is unrelated to the device identifier. (Col. 3 lines 51-57) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable, switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Parsons in view of Peck differs from the claimed invention by not explicitly reciting the anonymous user identifier is unrelated to the authentication information.

In an analogous art, Demello teaches a system and method for delivering personalized content to an anonymous user (Abstract), which includes creating an anonymous user identifier that is unrelated to a device identifier and authentication information. (Page 3 [0035] "one or more specific identifiers on Mediation Servers" & [0038] "The anonymous identification must not allow the determination of the identity of the wireless users") At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the content provider of Parsons in view of Peck after modifying it to incorporate the use of an anonymous user identifier of Demello. One of ordinary skill in the art would have been motivated to do this since it enables a mobile user to receive personalized information while maintaining anonymity with the content providers. (Demello Page 2 [0019])

Regarding claim 17, Parsons in view of Peck and Demello teaches a personalization interface is configured to receive the device identifier and the processor is configured to use the device identifier to personalize device-specific content for the at least one of the mobile stations, and to provide the personalized device-specific content to the at least one of the mobile stations.

(Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and

Col. 5 lines 18-21)

Regarding claim 20, Parsons in view of Peck and Demello teaches the anonymous user

identifier is the SIM serial number (Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines

21-33) assigned, at least in part, by the manufacturer of the SIM. (Peck Col. 8 lines 50-52 "the

32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 21, the limitations of claim 21 are rejected as being the same reason set

forth above in claim 10.

Regarding claim 22, Parsons in view of Peck and Demello teaches the selected

anonymous user identifier is the serial number of the SIM card. (Peck Col. 3 lines 51-57, Col. 4

lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be

generated by the operator or SIM card manufacturer")

Regarding claim 23, the limitations of claim 23 are rejected as being the same reason set

forth above in claim 17.

Regarding claim 24, Parsons in view of Peck and Demello teaches wherein the content

provider has a plurality of user profiles, each user profile of the plurality of user profiles having a

device identifier and an anonymous user identifier, the method further comprising at the content

provider:

selecting a user profile from the plurality of user profiles, the selected user profile having

a device identifier identical to the device identifier of the wireless device and an anonymous user

identifier identical to the anonymous user identifier of the wireless device; (Parsons Col. 8 lines

56 through Col. 9 line 3, Col. 14 lines 34-48 and Peck Col. 1 lines 37-39 and Col. 7 line 36 through Col. 8 line 11) and

selecting content based on the selected user profile. (Parsons Col. 14 lines 34-48, Peck Col. 2 lines 12-61, Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 25, Parsons in view of Peck and Demello teaches a method of using a wireless device to obtain anonymous personalized content from a content provider (Parsons Col. 8 lines 56-61 & Demello Page 2 [0022-0026]), the wireless device comprising a device identifier (Peck Col. 3 lines 51-53 terminal based ESN) and a subscriber identity module (SIM) having authentication information (Peck Col. 7 line 38 "AUTHR") and a serial number assigned, at least in part, by a manufacturer of the SIM (Peck Col. 8 lines 50-52), the serial number being unrelated to the authentication information (Demello Page 3 [0035] "one or more specific identifiers on Mediation Servers" & [0038] "The anonymous identification must not allow the determination of the identity of the wireless users") and the device identifier (Peck Col. 3 lines 51-57), the method comprising:

by selecting an anonymous user identifier based, at least in part, on a serial number assigned by a SIM manufacturer; (Peck Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

providing the anonymous user identifier to the content provider; (Parsons Col. 8 line 56 through Col. 9 line 29)

waiting for the content server to send anonymous personalized content identified by the content provider based on the anonymous user identifier for delivery to the wireless device; (Parsons Col. 1 line 59 through Col. 2 line 32 and Col. 8 line 56 through Col. 9 line 3) and

receiving the anonymous personalized content from the content provider. (Parsons Col. 14 lines 40-44)

Regarding claim 36, Parsons in view of Peck and Demello teaches the transmitter is configured to receive a request for additional identification information from the network, to communicate the request to the processor, and following receipt of a transmit response command from the processor, to transmit a response to the request to the network, (Parsons Col. 5 lines 19-31)

following communication of the request to the processor, the processor is configured to issue a display command directing the display to display the request, (Parsons Col. 5 lines 19-20)

the display is configured to receive the display command from the processor and following receipt of the display command, to display to the user the request received by the transmitter from the network, (obvious, otherwise the user doesn't know to login using their user ID and password Parsons Col. 5 lines 20-21)

the user input interface is configured to receive a response from the user to the request displayed to the user and to provide the response to the processor, (obvious otherwise the user will never be logged in) and

the processor is configured to issue the transmit response command to the transmitter directing the transmitter to transmit the response to the network. (Parsons Col. 5 lines 29-31)

Regarding claim 37, Parsons in view of Peck teaches the content personalization interface is configured to receive the anonymous personalization data from the at least one of the mobile stations; (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21) and

the processor is configured to use the device identifier to personalize device-specific content for the at least one of the mobile stations, and to provide the personalized device-specific content to the at least one of the mobile stations. (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 38, Parsons in view of Peck teaches a database (Parsons Fig. 3 [38a & 38b]) configured to store the anonymous personalization data received by the content personalization interface from the at least one of the mobile stations and to provide the anonymous personalization data to the processor. (Parsons Col. 9 lines 4-29 and Col. 14 lines 40-44)

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MATTHEW C. SAMS whose telephone number is (571)272-

8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, George Eng can be reached on (571)272-7495. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

MCS
7/9/2008